

REMARKS

## Status of the Claims

Claims 1-9, 11-14, 16, 18, 21, 22 and 27-41 remain pending in the application, Claims 1, 29, and 35 having been amended in this response and Claims 10, 15, 17, 20, 23-26 having been previously cancelled.

## Claims Rejected Under 35 U.S.C. § 112

The Examiner has rejected Claims 1-9, 11-14, 16, 18, 21, 22, and 27-41 under 35 USC § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. First, the Examiner asserts that the invention cannot be determined because it is unclear what comprises a “genesis document.” He indicates that “genesis document” will be given its broadest, reasonable interpretation and will thus be interpreted as a beginning or starting document. However, applicants respectfully disagree with this interpretation and note that it is not necessary for the Examiner to make any assumptions about the intended meaning of the term “genesis document,” because this term is clearly defined and explained in the specification, as a document that is in HTML format. Furthermore, in an exemplary embodiment, a genesis document is described as a curriculum standards document (see applicants’ specification, page 3, lines 33 - 36), which is a document commonly used by educational administrators to define learning objectives, by subject, for students and may serve as a basis for developing lesson plans for use by teachers (see applicants’ specification, page 6, lines 21-24). Accordingly, applicants respectfully request that the Examiner withdraw this rejection.

Second, the Examiner asserts that the invention cannot be determined because it is unclear what comprises a “test search.” The Examiner again states that “test search” will be given its broadest reasonable interpretation and will be interpreted as an initial search or first search. However, applicants again respectfully disagree with this interpretation of the claim language. There is no ambiguity in regard to the intended meaning of “test search,” which is defined in the specification as a search of the site catalog for all documents meeting the parameters specified in the search criteria dialog (see applicant’s specification page 22, lines 21-24). However, Claim 1 and Claim 29 have been amended to clarify that the test search is initiated by activating a test search control that causes a search engine to search the document source for all documents relevant to the plurality of search parameters. These claims also clearly indicate that the purpose of making a test

1 search is to evaluate whether search parameters used in the test search are likely to return desired  
2 results when used by another user to make a search of the document source. In other words, the test  
3 search enables the user “to determine whether the plurality of search parameters should be adjusted to  
4 satisfy an intended use by a different user who will use the plurality of search parameters to obtain  
5 search results by accessing a search link created by the user.” Accordingly, applicants respectfully  
6 request that the Examiner withdraw this rejection.

7 Third, the Examiner asserts that the invention cannot be determined, because it is unclear  
8 what comprises “test search results are desirable.” The Examiner again notes that the term  
9 “desirable” will be given its broadest reasonable interpretation and will be thus interpreted as search  
10 results which are viewed by a user. Applicants once more respectfully disagree with this  
11 interpretation, which is not justified in view of the language used in the claims and further, in view of  
12 the explanation of the present invention provided in the specification. Also, applicants have already  
13 defined this step in the specification, as explained in the response to an earlier Office Action.  
14 Nevertheless, Claims 1 and 29 have been amended to recite that the test search results are presented  
15 to a user for a determination as to whether the plurality of search parameters should be adjusted to  
16 satisfy an intended use by a different user who will use the plurality of search parameters to obtain  
17 search results by accessing a search link created by the user. Specifically, in the genesis document,  
18 the user selects a location in the document to place a search link and then specifies search criteria  
19 (i.e., the plurality of search parameters) for the link that will be used by an advanced search engine.  
20 The user can then refines the search parameters that are used in the test search query until a  
21 satisfactory set of documents is returned (see applicants’ specification, page 3, line 36 – page 4,  
22 line 7). Accordingly, applicants respectfully request that the Examiner withdraw this rejection.

23 Fourth, the Examiner asserts that the invention cannot be determined because it is unclear  
24 what comprises “a search link which corresponds to a plurality of search parameters.” In assessing  
25 the meaning of this phrase, the Examiner again indicates that “corresponding” will be given its  
26 broadest reasonable interpretation and will be interpreted as one or more of a plurality of search  
27 terms. Applicants respectfully disagree that this phrase as used in the claims to define the invention  
28 is unclear. But in the interest of reaching a common ground of understanding, applicants have  
29 amended Claim 1 and Claim 29 to recite that the user embeds a search link having the plurality of  
30 search parameters into the genesis document. The specification discloses that the search parameters

reflect concepts that the user wants a different user to be able to access (see applicants' specification, page 3, lines 21-24) by searching the documents on the document source. Accordingly, applicants respectfully request that the Examiner withdraw this rejection.

Fifth, the Examiner asserts that the invention cannot be ascertained because the difference, if any, between test search results and search results is unclear. The Examiner assumes that no difference exists between test search results and search results. Applicants respectfully disagree, but have amended Claim 1 and Claim 29 to clarify that documents comprising the plurality of documents on the document source can change over time. The document source is periodically updated so that test search results at one point in time can easily vary from search results at a later time, for example, if an update to the document source has been made. Clearly, the results seen when the search is run after the mix of documents on the document source changes can be different in terms of actual documents retrieved from the document source comprising a site catalog, because the site catalog is periodically updated. These updates may eliminate some documents, and add others. Thus, the specific documents returned in the test search can vary from the search performed by a different user activating a search link at another time (see applicants' specification, page 26, lines 16-20). Accordingly, applicants respectfully request that the Examiner withdraw this rejection.

The Examiner has also rejected Claims 2-9, 11-14, 16, 18, 21, 22, 27, 28 and 30-41 because these claims are dependent from a rejected base claim. However, as discussed above, Claim 1 and Claim 29 have been amended to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Accordingly, applicants respectfully request that the Examiner withdraw the rejection of the dependent claims under 35 U.S.C. § 112, since the dependent claims no longer depend from a base claim that is unclear.

Claims Rejected under 35 U.S.C. § 103(a)

Claims 1, 3-5, 7-9, 13, 29, 31-33 and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fields et al. (U.S. Patent No. 6,347,943, hereinafter "Fields") and further in view of Wang et al. (U.S. Patent No. 5,222,234, hereinafter "Wang"). The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fields to include performing a test search of a document source to identify test search results that satisfy a plurality of search parameters, and in response to performing the test search, retrieving the test search results and presenting the test search results to a user for a determination as to whether the test search

1 results are desirable as taught by Wang for the purpose of finding information related to the subject  
2 matter of the document. In addition, it would have been obvious to one of ordinary skill in the art at  
3 the time the invention was made to modify Fields to include the step of embedding a search link in a  
4 genesis document for the purpose of saving the search parameters. The Examiner indicates that a  
5 skilled artisan would have been motivated to improve the invention of Field for the purpose of  
6 providing increased utility to a reader of the document by making information related to the  
7 document easily accessible to the reader and to improve the invention of Fields such that the user is  
8 able to quickly and accurately retrieve particular documents. Applicants respectfully disagree for the  
9 reasons discussed below.

10 In the interest of reducing the complexity of the issues for the Examiner to consider in this  
11 response, the following discussion focuses on independent Claims 1 and 29. The patentability of  
12 each remaining dependent claim is not necessarily separately addressed in detail. However,  
13 applicants' decision not to discuss the differences between the cited art and each dependent claim  
14 should not be considered as an admission that applicants concur with the Examiner's conclusion that  
15 these dependent claims are not patentable over the disclosure in the cited references. Similarly,  
16 applicants' decision not to discuss differences between the prior art and every claim element, or every  
17 comment made by the Examiner, should not be considered as an admission that applicants concur  
18 with the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe  
19 that all of the dependent claims patentably distinguish over the references cited. However, a specific  
20 traverse of the rejection of each dependent claim is not required, since dependent claims are  
21 patentable for at least the same reasons as the independent claims from which the dependent claims  
22 ultimately depend.

23 Independent Claims 1 and 29

24 The Examiner asserts that Figure 1 and column 4, lines 45-58 of Wang discloses the fourth  
25 step of applicants' Claim 1, which recites "presenting the test search results to a user for a  
26 determination as to whether the test search results are desirable" and discloses applicants' the  
27 function of Claim 29, wherein the processor is caused to "display test search results received from the  
28 remote server in response to the test search on a display device, enabling a user to determine whether  
29 the test search results are desirable. The Examiner asserts that if the user has read all documents  
30 included in the search, the search results are acceptable and refers to Wang, column 6, lines 37-40.

1 Also on page 5 of the Office Action, the Examiner asserts that the test results must be desirable, since  
2 the user is informed of successful completion of a search, with reference to Wang, Figure 3A and  
3 column 5, lines 58-65.

4 However, the fact that a search has been completed is not a basis for concluding that the  
5 results from the search are desirable. Accordingly to that logic, it would never be necessary to refine  
6 search parameters when making a search, so long as the search returned any results. Obviously, a  
7 search has to occur to produce results so that a user can evaluate the results and determine whether  
8 the results are satisfactory. If not, the user can modify the search parameters used as necessary to  
9 obtain satisfactory results. Accordingly, the completed search in Wang does not imply that a user has  
10 determined whether the results are satisfactory. Furthermore, the Examiner's citation to Wang in  
11 column 6, lines 37-40 does not teach or suggest determining whether a plurality of search parameters  
12 should be adjusted to satisfy an intended use by a different user. Thus, Wang neither discloses  
13 applicants' fourth step of Claim 1 "presenting the test search results to a user for a determination as to  
14 whether the test search results are desirable" nor discloses applicants' Claim 29 limitations of the  
15 processor caused to "display test search results received from the remote server in response to the test  
16 search on a display device, enabling a user to determine whether the test search results are desirable."

17 The Examiner has asserted that Wang discloses applicants' fifth step of Claim 1 and  
18 applicants' processor step of Claim 29 of embedding a search link in the document and cites the  
19 search result document (Wang, column 7, lines 58-65). However, Wang's Search Result Document  
20 includes: (1) search criteria used with search; (2) the results of the search; and (3) the contextual  
21 search probe information, but not an embedded search link for use by another user to make a search.  
22 Thus, since Wang does not teach or suggest embedding a search link to create an embedded search  
23 link document, it follows (as further claimed in applicants' fifth step of Claim 1 and applicants'  
24 processor step of Claim 29) that Wang's search result document is not operative to initiate a search of  
25 a document source for search results that match a plurality of search parameters and to retrieve search  
26 results, ***when the search link is activated.***

27 Dependent Claim 3 and Claim 31

28 With respect to dependent Claim 3 and Claim 31, the Examiner asserts that the combination  
29 of Fields and Wang disclose the elements of Claim 1 and Claim 29, and that Fields discloses that the  
30 embedded search link document comprises an interactive lesson plan. However as discussed above,

1 Wang does not teach or disclose an embedded search link document. Therefore, the combination of  
2 Wang and Fields cannot teach or suggest that an embedded search link document comprises an  
3 interactive lesson plan.

4 Dependent Claim 7 and Claim 35

5 With respect to dependent Claim 7 and Claim 35, the Examiner asserts that Fields discloses  
6 the steps of receiving filtered tests search results, designating at least one of the filtered test search  
7 results as the preferred link, compressing and storing as a portion of the genesis document, a  
8 document identifier corresponding to the preferred link and cites lines 13-20 of Column 5 of Fields.  
9 However, although this citation discloses that users are able to save a link, nevertheless, it does not  
10 teach or suggest receiving filtered test search results. Accordingly, dependent Claims 7 and 35 are  
11 also patentable over the art of record.

12 Because dependent claims are considered to include all of the elements of the independent  
13 claims from which the dependent claims ultimately depend, and because the art cited does not  
14 disclose or suggest all the elements of independent Claims 1 and 29, the rejection of dependent  
15 Claims 3-5, 7-9, 13, 31-33 and 35 over Fields and further in view of Wang should be withdrawn, and  
16 these dependent claims are patentable for at least the same reasons as Claims 1 and 29.

17 Dependent Claim 2 and 30

18 Claims 2 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the  
19 combination of Fields and Wang and further in view of Tateno (U.S. Patent No. 5,812,999, hereinafter  
20 “Tateno”). The Examiner asserts that it would have been obvious to one of ordinary skill in the art at  
21 the time of the invention to modify the combination of Fields and Wang to include compressing and  
22 storing the test search query as taught by Tateno for the purpose of efficiently searching and  
23 retrieving any of the stored words. However, as explained above, the combination of Fields and  
24 Wang does not disclose all of the steps of Claim 1 or Claim 29. Further, Tateno does not disclose or  
25 teach compressing and storing the test search query as a portion of a genesis document so that  
26 activating a search link causes a test search query to be accessed. There is no operative search link to  
27 be activated in the art cited. Furthermore, even if, *arguendo*, the combination of Fields and Wang did  
28 disclose that a search link were embedded in a search link document, and that the search link was  
29 operative to cause a test search query to be accessed, the citation to Tateno appears to be directed  
30 towards compressing a body of text and then listing every word in the text and indicating at what

1 compressed block starting location each word appears in the text. Thus, Tateno's list, instead of  
2 comprising a plurality of search parameters useful in a query appears to simply be a listing of every  
3 word available in a given piece of text. Toteno appears to disclose a method of compressing entire  
4 pieces of text, and a keyword indexing system, but does not teach or suggest compressing and storing  
5 a test search query.

6 Accordingly, since Fields and further in view of Wang and Tateno do not teach or suggest all  
7 the elements of applicants' claimed invention, the rejection of dependent claims 2 and 30 should be  
8 withdrawn. In addition, because dependent claims are considered to include all of the elements of the  
9 independent claims from which the dependent claims ultimately depend, the rejection of dependent  
10 Claims 2 and 30 should be withdrawn for at least the same reasons as the rejections of Claims 1 and  
11 29, respectively.

12 Dependent Claims 6 and 34

13 Claims 6, 11, 16, 18, 34, 36, 40, and 41 are rejected under 35 U.S.C. § 103(a) as being  
14 unpatentable over the combination of Fields and Wang and further in view of Eisendrath et al. (Pub.  
15 No. U.S. 2001/0044833, hereinafter "Eisendrath"). With respect to his rejection of dependent  
16 Claims 6 and 34, the Examiner asserts that Eisendrath discloses a site catalog in paragraph 43.  
17 Therefore, the Examiner concludes that it would have been obvious to one of ordinary skill in the art  
18 at the time the invention was made to modify the combination of Fields and Wang to include a site  
19 catalog. However, applicants specifically define a site catalog as essentially comprising a  
20 compilation of all documents found by the search engine and determined by the Boolean filter to be  
21 relevant to potential search requests received in the search criteria dialog (see applicants'  
22 specification, page 12, line 16 through 19). In contrast, paragraph 43 of Eisendrath simply appears to  
23 list areas that can be accessed via students, for example, the course catalog of a faculty director,  
24 academic policies, and an academic school calendar. Eisendrath simply seems to present a helpful  
25 web site to potential students, instead of search for information using a search engine, and then  
26 filtering the results.

27 Accordingly, since the combination of Fields, Wang, and Eisendrath does not teach or suggest  
28 all the elements of applicants' claimed invention, the rejection of dependent Claims 6 and 34 should  
29 be withdrawn for the reasons noted above. In addition, because dependent claims are considered to  
30 include all of the elements of the independent claims from which the dependent claims ultimately

1 depend, dependent Claims 6, 11, 16, 18, 34, 36, 40, and 41 are patentable for at least the same  
2 reasons as the Claims 1 and 29.

3 Dependent Claims 12, 14, and 37

4 Claims 12, 14, and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the  
5 combination of Fields and Wang and further in view of Rutledge et al. (U.S. Pat No. 6,650,998,  
6 hereinafter “Rutledge”). However, because dependent claims are considered to include all of the  
7 elements of the independent claims from which the dependent claims ultimately depend, dependent  
8 Claims 12, 14, and 37 are patentable for at least the same reasons as Claims 1 and 29.

9 Dependent Claims 21, 22, 27, 28, 38, and 39

10 Claims 21, 22, 27, 28, 38, and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable  
11 over the combination of Fields and Wang and further in view of Byrne et al. (U.S. Pat No. 6,539,382,  
12 hereinafter “Byrne”). Again, because dependent claims are considered to include all of the elements  
13 of the independent claims from which the dependent claims ultimately depend, the rejection of  
14 dependent Claims 21, 22, 27, 28, 38, 39 should be withdrawn, and these claims are patentable for at  
15 least the same reasons as Claims 1 and 29.

16 In view of the amendments and Remarks set forth above, it will be apparent that the claims in  
17 this application define a novel and non-obvious invention, and that the application is in condition for  
18 allowance and should be passed to issue without further delay. Should any further questions remain,  
19 the Examiner is invited to telephone applicants’ attorney at the number listed below.

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Respectfully submitted,

*Ron Anderson*

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RMA/SKM:lrg

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MAILING CERTIFICATE:

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Date: February 22, 2005

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